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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,055	12/31/2003	Yoko Motoda	1686-0108P	8334
2292	7590	01/04/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			AKHAVAN, RAMIN	
			ART UNIT	PAPER NUMBER
			1636	
DATE MAILED: 01/04/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No. 10/748,055	Applicant(s) MOTODA ET AL.	
Examiner Ramin (Ray) Akhavan	Art Unit 1636	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12/08/2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): 17-23.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: 17-23.  
Claim(s) objected to: 16.  
Claim(s) rejected: 14-15 and 24-33.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See continuation sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

  
DAVID GUZO  
PRIMARY EXAMINER

Continuation sheet of form PTOL-303:

3. The amendments after final rejection have not been entered. The amendment to claim 14 raises issues that would require new search and/or consideration. The proposed amendments substantially alter the scope and substance of claim 14. For example, as pending, claim 14 was directed to a single PCR amplification, whereas the proposed amendment introduces additional steps and components required for a second amplification (i.e., step *ii*). As such, the proposed amendment is not entered. Further, where a single amendment is not entered, none of the proposed amendments are entered (thus claim 16 is not canceled).

11. The request for reconsideration has been considered, and Applicant's reply is sufficient to overcome the rejection under Lanar et al. as to claim 17-23. However, the reply is not sufficient to overcome the rejection as to claims 14-15 and 24-33. Further, as the proposed amendments to are not entered, Applicant's arguments grounded on said proposed amendments are rendered moot.

Applicant's arguments with respect to dependent claim 16 (base claim 15) independent claim 17 (dependent claims 18-23) are deemed persuasive. Claim 16 is objected to as being dependent on a rejected claim, but otherwise allowable if rewritten in independent form with all intervening limitations. Claim 16 provides the further limitation that the sense primer and the antisense primer is the same as the anti-sense primer. The specification describes by "same" it is meant that the sense and antisense primer have the same sequence. (e.g., ¶ 0019; all references herein correspond to the published version of this application, i.e., 2004/0214292). As Applicant

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points out, Lanar does not teach that the corresponding primers have the same sequence (e.g., Fig. 6, primers "A", "B" or "H3T7"). For this reason, the rejection is withdrawn as to claim 16.

As to claim 17, Applicant asserts that the method requires the step where the first downstream primer anneals with a portion of a vector sequence, which is necessarily distinct from the template DNA taught in Lanar. (e.g., Specification, ¶ 0031; teaching that the 3' is designed to anneal with a region of the plasmid vector downstream from the DNA template encoding the protein). As such the rejection is withdrawn as to independent claim 17 (dependent claims 18-23).

As to the remaining claims (14-15 and 24-33), in light of the fact that the proposed amendments are not entered, said claims stand rejected over Lanar for reasons of record. Applicant has not set forth additional arguments with respect to said claims, exclusive of those based on the proposed amendments or based on the distinguishing embodiment of claim 17. In summary, claims 14-15 and 24-33 stand rejected, claim 16 is objected to as dependent on an allowable claim and claims 17-23 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramin (Ray) Akhavan whose telephone number is 571-272-0766. The examiner can normally be reached on Monday-Friday from 8:30-5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ray Akhavan/AU 1636